REMARKS

Applicants have updated the title, and have amended claims 1 and 7 to differently recite the invention. Accordingly, claims 1-19 are currently pending for consideration. Claims 16-19 are withdrawn.

In the pending Office Action, the title stands objected to as allegedly not being descriptive; claim 7 stands rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; claims 1-5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Naoki et al. (Japanese Patent Publication No. 2004-001076, hereinafter "Naoki"); claims 6-10, 14, and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Naoki; and claims 11-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Naoki and further in view of Fukuyo et al. (European Patent Publication No. EP 1 338 371, hereinafter "Fukuyo"). Applicants traverse these rejections, at least for the following reasons.

Applicants appreciate the Examiner's proposed title. However, Applicants are not sure how the Examiner's proposed title matches with the claims as presently amended. Accordingly, Applicants have amended the title in a manner somewhat different from the title proposed by the Examiner. Reconsideration and withdrawal of the object to the title are respectfully requested.

Claim 7 stands rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Applicants have newly-amended dependent claim 7 to improve the form of the claim. Applicants respectfully submit that claims 1-15 now fully comply with the requirements of 35 U.S.C. § 112, second paragraph. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, are respectfully requested.

As for the rejections based on art, claims 1-5 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Naoki; claims 6-10, 14 and 15 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Naoki; and claims 11-13 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Naoki, and further in view of Fukuyo. Applicants have newly-amended independent claim 1 to differently recite the invention. Among other things, although Applicants do not necessarily agree with the Examiner's interpretation and application of the law as presented at pages 3-4 and 7-8 of the Office Action, Applicants have amended claim 1 so that all of the language in the steps of the recited method are positively recited as that terminology has been interpreted by the Examiner (*e.g.*, the "wherein" terminology has now been replaced). To the extent that the aforementioned rejections might be deemed to still apply to the claims as newly-amended, they are respectfully traversed for at least the following reasons.

In this regard, Applicants respectfully submit that neither the applied reference to Naoki, nor any other applied reference, whether viewed alone or in combination, discloses or would have rendered obvious Applicants' claimed method(s) comprising a step of forming at least one row of a second modified region along a cutting line at a position between the first modified region closest to a rear face of the substrate and the rear face; generating a fracture extending along the cutting line from the second modified region to the rear face; expanding an expandable film bonded to the rear face of the substrate; and cutting the substrate and the laminate part along the cutting line by advancing the fracture from the substrate to the laminate part by way of the first modified regions. The Office Action does not assert that the applied references teach or suggest such subject matter, nor do they. Accordingly, for at least this reason, Applicants submit

the present claims patentably distinguish over the applied references of record, whether viewed singly or taken in combination.

As pointed out in the previous response, the novel and non-obvious aspects of the present invention provide various advantages not found in the applied art. For example, "even when the substrate formed with the laminate part including a plurality of functional devices is thick, this laser processing method can cut the substrate and laminate part with a high precision." Applicants respectfully submit that these features and advantages are discussed, for example, at paragraphs [0006] and [0061] - [0062] in the specification of the corresponding PCT specification.

Accordingly, for at least the foregoing reasons, Applicants respectfully assert that the rejections under 35 U.S.C. §§ 102(b) and 103(a) should be withdrawn because Naoki does not teach or suggest each feature of independent claim 1 of the instant application. Moreover, the other applied reference does not make up for the deficiencies in Naoki. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Similarly, MPEP § 2143.03 instructs that "'[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.' In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." Since the prior art does not disclose or render obvious any of the combinations recited in Applicants' claims, and if anything appears to teach away from the current claim recitations, KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727 (2007), Applicants submit that such recited

combinations would not have been obvious in view of the applied references of record, whether taken alone or combined in the manner suggested by the Examiner in the Office Action.

Furthermore, Applicants respectfully assert that dependent claims 2-15 are allowable at least because of their dependence from independent claim 1, and the reasons discussed previously. With regard to the additionally-applied reference to Fukuyo as to claims 11-13, as mentioned, Applicants respectfully submit that Fukuyo does not cure the deficiencies discussed above of Naoki.

In view of the foregoing, Applicants respectfully submit that independent claim 1, and the claims dependent therefrom, patentably distinguish over the applied references of record. Accordingly, reconsideration and withdrawal of the rejections applied to the claims in the pending Office Action are respectfully requested, and an early allowance of the present application is earnestly solicited.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are in condition for allowance, and respectfully request reconsideration and timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. A favorable action is awaited.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

DRINKER BIDDLE & REATH LLP

Dated: March 28, 2011 By: _____
John G. Smith
Reg. No. 33,818

Customer No. 055694
DRINKER BIDDLE & REATH LLP
1500 K Street, N.W., Suite 1100
Washington, DC 20005-1209
Tel.: (202) 842-8800
Fax: (202) 842-8465